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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,775	06/06/2005	Norihiko Nakahara	07409.0041-00000	4612
22852	7590	04/18/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER	
			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	
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			04/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,775	<b>Applicant(s)</b> NAKAHARA ET AL.
	<b>Examiner</b> ALVIN A. HUNTER	<b>Art Unit</b> 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 March 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,6,8 and 9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,6 and 9 is/are rejected.

7) Claim(s) 8 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/DS/06)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

Claim 7 as erroneously omitted in the previous action as being an elected claim; therefore, claim 7 has been rejoined and an action on the merit are as follows:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimusa et al. (JP 07-155410) in view of Soracco (USPN 6743118) and Nakahara et al. (US 2003/0083151).

Regarding claim 1 and 9, Nishimusa et al. discloses a club head having a face portion, crown portion, heel portion, toe portion, and sole portion wherein at least two portions of the club head is made of dissimilar materials. Nishimusa notes that the club head is made of FRP and metals and can be attached using adhesive. One having ordinary skill in the art would have found it obvious to have the club head made of any material so long as the specific gravity gets larger toward the back of the club head. Nishimusa et al. does not disclose the distance in which the two portions are attached or the type of attachment. Soracco discloses a club head having a face plate being separately attached to the club head and integrally formed. Soracco also has a face portion in which the face plate is attached that is 0.20 to 1.50 inches from the

attachment point of the body. One having ordinary skill in the art would have found it obvious to have the face plate attached the in above manner in order to improve the integrity of the face plate such that is durable. Nakahara discloses a club head having a face crown, sole, heel, and toe wherein the face is connected to a number of members by FRP materials. Nakahara et al. notes the FRP may be attached in a number of ways wherein a few figures, in particular figure 2c and 8C show the FRP material joined to a first and second member of at least two portions, and that the size of the opening that the FRP material fits may vary wherein particular Figure 3F shows a rap-around opening between the rear and the front of the club head. Figures 5B-6 also show the connection point of the FRP material spaced from the front of the face plate. One having ordinary skill in the art would have found it obvious to attach the FRP in an overlapping manner as taught by Nakahara et al., in order to secure the two portions together.

Regarding claim 6, Nishimusa et al. discloses the dissimilar materials being titanium, aluminum, stainless steel, and magnesium.

Regarding claim 7, Nishimusa et al. does not disclose the elastic modulus of the FRP material. Nakahara et al. discloses the FRP material having an elastic modulus of less than  $27 \times 10^3$  kg-f/mm<sup>2</sup>. One having ordinary skill in the art would have found it obvious to have the above elastic modulus, as taught by Nakahara et al., in order to improve vibration dampening.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 6, 8, and 9 are have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN A. HUNTER whose telephone number is

(571)272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A. A. H./

Examiner, Art Unit 3711

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711